

REMARKS

This paper is filed responsive to the Final Office Action mailed February 4, 2009. Claims 1-13, 15-19 are pending in the application. Claims 1, 2, 15 and 16 are amended. Claim 14 has been canceled. Claims 17-19 are new. No new matter has been added.

Claims 1-4, 7-11 and 15-16 stands rejected under 35 U.S.C. 102(e) as being anticipated by White (U.S. Patent No. 6,656,184). Applicant traverses the rejection.

Applicant contends that White does not anticipate claim 1. Claim 1 has been redrafted to conform to U.S. claiming convention. Claim 1 claims a bone marker for use in image guided surgery that includes an anchor mechanism configured to be attached to a bone; a support having a first end and a second end, the first end attached to the anchor mechanism; and at least one reference member attached to the second end of the support, the at least one reference member configured to be detected by an image guided system to identify the location of the at least one reference member relative to the bone, wherein the support comprises at least one resiliently deformable limb configured such that, when the anchor mechanism is attached to the bone, at least a portion of the at least one limb extends away from the bone.

White does not describe the claimed invention. As described in the prior response, White describes a bone screw for securing two or more bone fragments together. The White bone screw has a distal portion 12 having a threaded surface, a proximal head portion 16 for driving the bone screw into bone, and an intermediate portion having a compressive member 22. The compressive member 22 is stretched prior to insertion into bone and filled with a resorbable material, which is *permitted to harden, thereby preventing the compressive member from returning to its relaxed state*. White, col 4:55-col 5:58 (describing the stretching and filling of a material that hardens). The bone screw of White is then screwed into a first bone fragment, as shown in Figures 4, and through and into a second bone fragment, as depicted in Figure 5, until

it resides almost entirely within the bone, as depicted in Figure 6. Thus, in its final state, when the anchoring member is disposed within the bone, the compressive member 22 of White is also disposed within the bone. To re-emphasize, in the state shown in Figure 4, the compressive member 22 of White is **not resilient**, as it has been filled with a material that is permitted to harden.

As a result, White cannot be said to describe a support that “comprises at least one resiliently deformable limb configured such that, when the anchor mechanism is attached to the bone, at least a portion of the at least one limb extends away from the bone”.

Further, White does not teach the “at least one reference member attached to the second end of the support, the at least one reference member configured to be detected by an image guided system to identify the location of the at least one reference member relative to the bone. White is a bone screw. No part of the screw is configured to be detected by an image guided system to identify the location of the at least one reference member relative to the bone. The Examiner has cited any reference in supporting this aspect of the rejection. It simply is not sufficient to state that stainless steel bone screws are known in the art to be detectable. Reference members are configured especially to be tracked by image guided systems. A bone screw with a head that is disposed at least partially within bone, as shown in Figure 6, is not configured to be detected by an image guided system.

For the foregoing reasons, Applicant submits that White does not anticipate claim 1. With reference to the dependent claims, White fails to describe the elements described in claims 2, 17 and 18. That is, White does not describe a bone marker that has a support that also includes at least one rigid limb (claim 2); does not describe a bone marker wherein the at least one resiliently deformable limb has a first end and a second end, the first end being attached to the anchoring member and the second end being attached to the at least one rigid limb (claim 17); and does not describe a bone marker of claim 17, wherein the first end of the at least one resiliently deformable limb is attached to the anchoring member (claim 18). It

should be noted that the Examiner failed to indicate how White anticipated claim 2 in the February 4, 2009 Office Action.

In addition, White fails to describe claim 4 (the spring has flat abutting surfaces), claim 15 (is configured to be deflected up to 90 degrees away from the axis before its elastic limit is exceeded) and 16 (is configured be deflected perpendicularly away from the axis by up to a distance of 70% of the axial length before its elastic limit is exceeded). Again, the Examiner failed to indicate in the February 4, 2009 Office Action how these claims were anticipated by White.

Finally, the Examiner fails to explain in any detail how White describes the limitations claimed in claims 8 and 9, which claim (among other elements) a coupling member for coupling the support to the fixation member, and wherein the coupling member is adjustable to allow rotation of the support about the fixation member.

Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over White as applied to claim 1 above, and further in view of Nassar (U.S. Patent No. 5,389,107). Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over White as applied to claim 1 above, and further in view of Lieberman (U.S. Patent No. 6,527,774). Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over White as applied to claim 1 above, and further in view of Carson (U.S. Pub No. 2002/0198451).

Applicant contends that claims 5, 6 and 12-13 are patentable at least as they depend from an allowable independent claim.

Please charge any deficiency or credit any overpayment to Deposit Account No. 10-0750/ DEP5167USPCT /BST.

Docket No. DEP5167USPCT
Serial No. 10/567235

Applicants submit that the application is presently in condition for allowance and request favorable reconsideration and early notice of allowance. If it would speed prosecution, the Examiner is encouraged to contact the undersigned attorney by telephone.

Respectfully submitted,

/Brian S. Tomko/

By: _____
Brian S. Tomko
Reg. No. 41349

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-1239
Dated: May 4, 2009